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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,857	09/25/2003	Sameer S. Marathe	03-106	2330
719 7590 12/17/2008				
Caterpillar Inc. Intellectual Property Dept. AH 9510 100 N.E. Adams Street PEORIA, IL 61629-9510				
EXAMINER				
SCHWARTZ, CHRISTOPHER P				
ART UNIT		PAPER NUMBER		
3657				
MAIL DATE		DELIVERY MODE		
12/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte*: SAMEER MARATHE

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Application No. 10/670,857  
Technology Center 3600

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Mailed: December 17, 2008

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Before TOI JOHNSON *Review Paralegal*  
JOHNSON, *Review Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on November 19, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF

Grounds of Rejection to be Reviewed on Appeal

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed June 18, 2007 under the heading “Grounds of Rejection to be Reviewed on Appeal” is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office action of record. Each Grounds of rejection to be reviewed on appeal must be identified.

Correction of the Grounds of Rejection to be Reviewed on Appeal for all claims is required.

EXAMINER’S ANSWER,  
INCONSISTENCIES WITH THE BRIEF AND  
LAST REJECTION OF RECORD

A review of the file finds inconsistencies between the last rejection of record and corresponding sections of the Examiner’s Answer as set forth below.

Final Rejection

A review of the Final Rejection mailed on October 27, 2005, finds the following status of the claims: claims cancelled: 2-9, 11-14 and 25-27,

claims allowed: NONE, claims rejected: 1, 10, 15-24 and 28-34 and claims withdrawn: NONE. However, claims 19, 21 and 22 is not included for review in the Final Rejection.

Examiner's Answer

On September 28, 2007, the Examiner mailed an Examiner's Answer in response to Appellants' Brief. Further review of the Examiner's Answer reveals that claims 19, 21 and 22 is not included in any statement of rejection for review by the Board of Patent Appeals and Interferences.

Clarification of claims 19, 21 and 22 is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed on June 18, 2007 defective;
- 2) notify Appellant to file a paper properly addressing the Grounds of rejection of all claims;
- 3) consider and acknowledge the Appeal Brief submitted by Appellant to correct the Grounds of Rejection;
- 4) vacate the Examiner's Answer mailed on September 28, 2007;
- 5) issue a corrected Examiner's Answer to clarify the rejection of claims 19, 21 and 22 and to correct other sections of the Answer as may be required;

6) include the necessary approval from the TC Director or designee in accordance with MPEP 1207.05, part (B) as may be required for any new grounds of rejection for claims 19, 21 and 22; and

7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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